

REMARKS

Claims 1-4 and 7-20 are now pending in this application. Claims 1, 7, 12, 16 and 17 are currently amended. Claims 2-4, 10 and 11 were previously presented. Claims 8, 9, 13-15 and 18-20 are original claims. Claims 5, 6, 21 and 22 are cancelled. No new matter has been introduced.

Applicant's invention, as now more clearly claimed, in a first aspect (claim 1 *et seq.*), is a protection device for use during outside activities for protection of a wearer against crawling insects such as deer ticks carrying Lyme Disease. The protection device comprises a set of protection elements for protection of at least two types of clothing openings selected from the group of types of clothing openings consisting of: waist band, shirt collar, shirt front, shirt sleeves, and pant cuffs. Each protection element of the set of protection elements comprises an elongate substrate having a first, inner surface and an opposite, second, outer surface, a first, inner adhesive layer adhered upon the first, inner surface of the substrate and having an adhesive surface that, upon exposure, releasably adheres the protection element upon a clothing surface in a region adjacent to a selected type of clothing opening, and a second, outer adhesive layer adhered upon the second, outer surface of the substrate and having an adhesive surface that, upon exposure, acts to impede advancement of insects crawling upon the clothing surface into contact with the adhesive surface of the second, outer adhesive layer from proceeding thereacross toward the selected type of clothing opening.

According to a second aspect of Applicant's invention (claim 16 *et seq.*), a method for protection against insects such as deer ticks carrying Lyme Disease crawling upon a clothing surface of a wearer toward clothing openings comprises protection of at least two types of clothing openings selected from the group of types of clothing openings consisting of: waist band, shirt collar, shirt front, shirt sleeves, and pant cuffs by the steps of: a) selecting a protection element from a set of protection elements comprising an elongate substrate having a first, inner surface and an opposite, second, outer surface, a first, inner adhesive layer adhered upon the first, inner surface of the substrate and having an adhesive surface, and a second, outer adhesive layer adhered upon the second, outer surface of the substrate and having an adhesive surface; b)

exposing the adhesive surface of the first, inner adhesive layer; c) applying the adhesive surface of the first, inner adhesive layer to a clothing surface to removably attach the protection element to the clothing surface adjacent to a selected type of clothing opening; d) exposing the adhesive surface of the second, outer adhesive layer to impede advancement of insects crawling upon the clothing surface from proceeding across the adhesive surface of the second, outer adhesive layer, toward the selected type of clothing opening; and e) repeating the steps a) through d) to adhere protection elements in regions of at least one additional type of clothing opening.

None of the prior art references cited by the Examiner, whether taken alone, or in any proper combination, teaches or suggests Applicant's invention as now more clearly claimed.

Submitted herewith is a supplemental declaration of the inventor, Paul Cosenza, under 37 CFR 1.131, along with a supporting declaration by Debra Secord, CEO of Precision Tape & Label, in Uxbridge, Massachusetts, establishing that the inventor conceived of the invention of independent claims 1 and 16, and of at least dependent claims 2-4, 7-9, 11 and 17-20¹ prior to December 4, 2000, the effective date of Arber '939, and establishing diligence in constructive reduction to practice of the invention from prior to December 4, 2000 until the U.S. provisional application was filed March 8, 2001. In particular, as established by the declarations, at least as early as November 2000, Mr. Cosenza disclosed the inventions of independent claim 1 and claim 16, and at least dependent claims 2-4, 7-9, 11 and 17-20, to Jerry Meratea, Vice President Sales and Marketing for Ideal Tape Co., Inc., in Lowell, Massachusetts, seeking the assistance of his company in development of my deer tick protection product. Mr. Meratea referred Mr. Cosenza to Deborah Secord, CEO of Precision Tape & Label, Inc., in Uxbridge, Massachusetts (§5, Cosenza Supplemental Declaration). Beginning in November 2000, and continuing for a period of about four months, Mr. Cosenza worked with Ms. Secord and Precision Tape & Label to develop his deer tick protection products (§6, Cosenza Supplemental Declaration; §2, Secord Declaration). During that period, Precision Tape & Label manufactured a series of prototypes for

¹ For clarity, the listing of dependent claims in this response has been modified to reflect the included amendments. The listing of claims in the declarations reflects the listing of dependent claims prior to amendment, i.e. 2-9, 11 and 17-22.

evaluation by Mr. Cosenza. A number of the prototype protection elements manufactured by Ideal Tape & Label performed acceptably in the manner of Mr. Cosenza's invention, as described in the declarations (§6, Cosenza Supplemental Declaration; §3, Second Declaration). On the basis of these successful tests, Mr. Cosenza retained patent counsel and subsequently filed his initial provisional patent application (§7, Cosenza Supplemental Declaration).

On this basis, we submit that Arber '939 is overcome as prior art, at least with respect to the features of claims 1-4, 7-9, 11 and 16-20, and that these claims are now in condition for allowance.

Claims 1, 5, 16 and 22 were rejected under 35 USC §102(e) as being anticipated by Arber US 6,353,939. We respectfully traverse.

Claim 1 is amended herein to recite a set of protection elements for protection of at least two types of clothing openings selected from the group of types of clothing openings consisting of: waist band, shirt collar, shirt front, shirt sleeves, and pant cuffs by attachment of protection elements adjacent the selected types of clothing openings to be protected. Claim 16 is similarly amended to recite a method comprising protection of at least two types of clothing openings selected from the group of types of clothing openings consisting of: waist band, shirt collar, shirt front, shirt sleeves, and pant cuffs, by applying protection elements adjacent the selected types of clothing openings.

In contrast, Arber '939 describes disposable, one-time use leggings for protection of the region of the pants cuffs. There is no teaching by Arber '939 for Applicant's invention of a set of protection elements, or a method of protection, for at least two types of clothing openings, as taught and claimed by Applicant; therefore, there can be no anticipation of Applicant's claims 1 and 16.

Claims 2-4, 6-9 and 17-21 were rejected under 35 USC §103(a) as being obvious and therefore unpatentable over Arber '939. We respectfully traverse.

Arber '939 does not teach, nor properly suggest, Applicant's invention of a set of protection elements, or a method of protection, for at least two types of clothing openings, as taught and claimed by Applicant. The Examiner proposes that disclosure in Arber '939 for disposable, one-time use plastic leggings for protection of the region of the pants cuffs would render Applicant's invention for a set of protection elements to be attached adjacent to the wearer's clothing adjacent multiple types of clothing openings obvious to a person of ordinary skill in the art.

Obviousness can only be established by combining or modifying the teaching of the prior art where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (See M.P.E.P. §2143.01) Motivation cannot come from the invention itself. (See, e.g., *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 1072 (Fed. Cir. 1993). Nor can *prima facie* obviousness be established by "using hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

Absent impermissible application of hindsight with Applicant's invention as a guide, the teaching of Arber '939 for disposable, one-time use plastic leggings for protection of the region of the pants cuffs provides no teaching nor proper suggestion for Applicant's invention of a set of protection elements, or a method of protection, for at least two types of clothing openings, as described by Applicants in the instant application. The motivations postulated by the Examiner for modifying, multiplying, reconfiguring and reconstituting the elements of the leggings taught by Arber '939 (i.e., "it has been held that mere duplication of essential working parts of a device involves only routine skill in the art" and "it has been held that mere duplication of essential working parts of a device and rearranging parts of an invention involves only routine skill in the art" and "a change in size is recognized as being within the level of ordinary skill in the art") do not provide the requisite suggestion for modifying the reference in a manner to achieve Applicant's invention, as now claimed.

Claims 10 and 11 were rejected under 35 USC §103(a) as being obvious and therefore unpatentable over Arber '939 taken in view of Geary US 2,911,756. We respectfully traverse.

Geary '756 teaches an improved sticky fly paper (col. 1, line 17) provided in the form of a roll (FIG.2) or a stack (FIG. 3). Arber '939, as discussed above, describes a disposable tubular plastic legging, through which the wearer's foot and lower leg are inserted, with an encircling adhesive region at midcalf. The motivation postulated by the Examiner for modifying, the leggings taught by Arber '939 (i.e., "it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a set of protection elements disclosed by Arber in the sheet or roll taught by Geary, since both forms are suitable for providing a preconfigured element") does not provide the requisite suggestion for modifying the leggings of Arber '939 to achieve the aspects of Applicant's invention shown in FIGS. 3, 5 and 7 of the instant application.

Claims 12-15 were rejected under 35 USC §103(a) as being obvious and therefore unpatentable over Arber '939 taken in view of Luria et al. US 5,381,557. We respectfully traverse.

Arber '939 describes a disposable, one-time use plastic legging. Luria '577 describes a band or cuff that acts as a barrier to ticks and crawling insects, and which, in one embodiment, includes an overhanging lip. Even if there is proper suggestion for combining these references in the matter proposed by the Examiner, which Applicant does not concede, Applicant's invention, including the features of claim 1 discussed above, would not be achieved.

Applicant again reserves the right to address other of the Examiner's positions, against which there are good arguments, on a point-by-point basis, which has presently been rendered unnecessary by the swearing back of the reference.


Applicant : Paul M. Cosenza
Serial No. : 10/083,000
Filed : February 26, 2002
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Attorney's Docket No.: 12912-002001

We submit that this application is now in condition for allowance. Early favorable action is solicited. Enclosed is Petition for Extension of Time with a check for \$210.00 in payment of the required fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: May 14, 2004



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